

Appln. No. 10/671,214  
Amendment dated November 17, 2004  
Reply to Office Action mailed August 17, 2004

### **REMARKS**

Reconsideration is respectfully requested.

Claims 1, 6 through 18 and 20 remain in this application. Claims 2 through 5 and 19 have been cancelled.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

#### **Paragraph 1 of the Office Action**

The drawings have been objected to.

Attention is directed to Figure 5 as submitted. Figure 5 is a cross-sectional view of Figure 4 and therefore shows the interior of output conduit. As can be seen in Figure 5, reference numbers "18" and "20" indicate the exterior outlet thread and the exterior inlet thread, respectively, on the outside of the output conduit. Reference numbers "19" and "21" indicate the interior outlet thread and the interior inlet thread, respectively, on the interior of the output conduit. Therefore, it is respectfully submitted the limitations of claims 9, 11, 15 and 17 are shown in the Figures as filed by the applicant.

It is therefore submitted that the objection to the drawings as originally filed has been overcome, and withdrawal of the objection to the drawings is respectfully requested.

#### **Paragraphs 2 and 3 of the Office Action**

Claims 1 through 4 and 10 have been rejected under 35 U.S.C. §102(b) as being anticipated by Schmidt.

It is submitted that the Schmidt reference does not disclose, teach or suggest "a seal member being selectively positioned around said output conduit, said seal member abutting against said backing member such that

Appln. No. 10/671,214

Amendment dated November 17, 2004

Reply to Office Action mailed August 17, 2004

said seal member is adapted for being positioned between said backing member and the wall of the structure, said seal member being adapted for sealing an area of the wall adjacent said output conduit such that said seal member is adapted for inhibiting environmental elements and insects from entering the structure between the wall and said output conduit". The Schmidt reference teaches a faucet that fails to teach a seal member being positioned against the backing member so that the seal member is positioned between the backing member and the structure to inhibit environmental elements and insects from entering the structure from around the output conduit as claimed by the applicant. Therefore, it is submitted that the Schmidt reference would not lead one to anticipate the combination of features as claimed by the applicant.

Claim 10 is dependent upon claim 1, particularly as amended, and therefore incorporates the requirements of claim 1. Thus, claim 10 is also believed to be allowable over the cited reference.

Claims 2 through 4 have been cancelled.

Withdrawal of the §102(b) rejection of claims 1 and 10 is therefore respectfully requested.

**Paragraph 4 of the Office Action**

Claims 1 through 3, 5 through 6, 9 and 11 have been rejected under 35 U.S.C. §102(b) as being anticipated by Collie.

It is submitted that the Collie reference does not disclose, teach or suggest "said backing member being positioned at an oblique angle to said output conduit, said backing member being adapted for abutting against an oblique exterior face of the wall to allow said backing member to apply force against the wall evenly to prevent said backing member from damaging the wall when said backing member abuts the wall". The Collie

Appln. No. 10/671,214

Amendment dated November 17, 2004

Reply to Office Action mailed August 17, 2004

reference teaches a multiple cable gland that fails to teach the backing member being positioned at an oblique angle to the output conduit to match the angle of the wall of the structure to apply even force against the structure and inhibit the backing member from damaging the structure as claimed by the applicant. Therefore, it is submitted that the Collie reference would not lead one to anticipate the combination of features as claimed by the applicant.

Claims 6, 9 and 11 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 6, 9 and 11 are also believed to be allowable over the cited reference.

Claims 2, 3 and 5 have been cancelled.

Withdrawal of the §102(b) rejection of claims 1, 6, 9 and 11 is therefore respectfully requested.

**Paragraph 5 of the Office Action**

Claims 1-3, 8 and 10 have been rejected under 35 U.S.C. §102(b) as being anticipated by Walsh et al.

It is submitted that the Walsh reference does not disclose, teach or suggest "said backing member being positioned at an oblique angle to said output conduit, said backing member being adapted for abutting against an oblique exterior face of the wall to allow said backing member to apply force against the wall evenly to prevent said backing member from damaging the wall when said backing member abuts the wall". The Walsh reference teaches a pass-through dual containment fitting that fails to teach the backing member being positioned at an oblique angle to the output conduit to match the angle of the wall of the structure to apply even force against the structure and inhibit the backing member from damaging the

Appln. No. 10/671,214  
Amendment dated November 17, 2004  
Reply to Office Action mailed August 17, 2004

structure as claimed by the applicant. Therefore, it is submitted that the Walsh reference would not lead one to anticipate the combination of features as claimed by the applicant.

Claims 8 and 10 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 8 and 10 are also believed to be allowable over the cited reference.

Claims 2 and 3 have been cancelled.

Withdrawal of the §102(b) rejection of claims 1, 8 and 10 is therefore respectfully requested.

**Paragraph 6 of the Office Action**

Claims 1 through 3 and 7 have been rejected under 35 U.S.C. §102(b) as being anticipated by Glauber.

It is submitted that the Glauber reference does not disclose, teach or suggest "said backing member being positioned at an oblique angle to said output conduit, said backing member being adapted for abutting against an oblique exterior face of the wall to allow said backing member to apply force against the wall evenly to prevent said backing member from damaging the wall when said backing member abuts the wall". The Glauber reference teaches a coupling pipe that fails to teach the backing member being positioned at an oblique angle to the output conduit to match the angle of the wall of the structure to apply even force against the structure and inhibit the backing member from damaging the structure as claimed by the applicant. Therefore, it is submitted that the Glauber reference would not lead one to anticipate the combination of features as claimed by the applicant.

Appln. No. 10/671,214  
Amendment dated November 17, 2004  
Reply to Office Action mailed August 17, 2004

Claim 7 is dependent upon claim 1, particularly as amended, and therefore incorporates the requirements of claim 1. Thus, claim 7 is also believed to be allowable over the cited reference.

Claims 2 and 3 have been cancelled.

Withdrawal of the §102(b) rejection of claims 1 and 7 is therefore respectfully requested.

**Paragraph 7 of the Office Action**

Claims 1 through 2 and 18 through 20 have been rejected under 35 U.S.C. §102(b) as being anticipated by Fritz et al '532.

It is submitted that the Fritz reference does not disclose, teach or suggest "said backing member being positioned at an oblique angle to said output conduit, said backing member being adapted for abutting against an oblique exterior face of the wall to allow said backing member to apply force against the wall evenly to prevent said backing member from damaging the wall when said backing member abuts the wall". The Fritz reference teaches a tub overflow waste assembly that fails to teach the backing member being positioned at an oblique angle to the output conduit to match the angle of the wall of the structure to apply even force against the structure and inhibit the backing member from damaging the structure as claimed by the applicant. Therefore, it is submitted that the Fritz reference would not lead one to anticipate the combination of features as claimed by the applicant.

Claims 18 and 20 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 18 and 20 also believed to be allowable over the cited reference.

Claims 2 and 19 have been cancelled.

Appln. No. 10/671,214  
Amendment dated November 17, 2004  
Reply to Office Action mailed August 17, 2004

Withdrawal of the §102(b) rejection of claims 1, 18, and 20 is therefore respectfully requested.

**Paragraphs 8 and 9 of the Office Action**

Claims 5 and 6 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Schmidt in view of Hawkins.

It is initially noted that the law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art:

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is submitted that the combination of Schmidt with Hawkins is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "a seal member being selectively positioned around said output conduit, said seal member abutting against said backing member such that said seal member is adapted for being positioned between said backing member and the wall of the structure, said seal member being adapted for sealing an area of the wall adjacent said output conduit such that said seal member is adapted for inhibiting environmental elements and insects from entering the structure between the wall and said output conduit". As, discussed above,

Appln. No. 10/671,214

Amendment dated November 17, 2004

Reply to Office Action mailed August 17, 2004

the Schmidt reference teaches a faucet that fails to teach a seal member being positioned against the backing member so that the seal member is positioned between the backing member and the structure to inhibit environmental elements and insects from entering the structure from around the output conduit as claimed by the applicant. The Official Action states:

Schmidt discloses a conduit system as described above, and discloses clamping the retaining member and backing member tightly against the wall in order to make a fluid tight connection.

Attention is directed to the Schmidt reference which is completely silent on the use of the rings "D" and "E" with the nut "E'" to make a fluid tight connection with the wall. The primary use of the rings "D" and "E" with the nut "E'" is to clamp to the wall, as shown in column 2, lines 47 through 58 and reiterated below, and in no way provides any suggestion that the rings are to be used to make a fluid tight connection with the wall.

The rings D E and nut E' form, with the shoulder C, a clamp which embraces or clamps the plate or wall through which the cock or faucet projects, and by reason of the described construction of these parts they clamp equally well an oblique or inclined wall or plate, or one having one surface inclined or oblique and the other straight r perpendicular to the axis of the shank B, and thus overcome a difficulty heretofore experienced in connecting faucets or cocks to inclined or oblique walls.

Thus, the Schmidt reference fails to provide any motivation for the combination with the seal of the Hawkins reference as suggested in the Official Action. Therefore, it is respectfully submitted that the combination of the Schmidt reference with the Hawkins reference would not lead one to the combination of features as claimed by the applicant.

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

Appln. No. 10/671,214

Amendment dated November 17, 2004

Reply to Office Action mailed August 17, 2004

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

Claim 6 is dependent upon claim 1, particularly as amended, and therefore incorporates the requirements of claim 1. Thus, claim 6 is also believed to be allowable over the cited reference.

Claim 5 has been cancelled.

Withdrawal of the §103(a) rejection of claim 6 is therefore respectfully requested.

Paragraphs 10 through 13 of the Office Action

Claims 12 and 14 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Glauber in view of Hawkins.

Claims 15 and 17 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Glauber in view of Hawkins as applied to claim 12 above, and further in view of Collie.

Claim 16 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Glauber in view of Hawkins as applied to claim 12 above, and further in view of Walsh.

Claims 12 through 17 have been cancelled, and therefore the §103(a) rejections of claims 12 through 17 are submitted to be moot.



Appln. No. 10/671,214  
Amendment dated November 17, 2004  
Reply to Office Action mailed August 17, 2004

**Added Claims**

Added claim 21 requires, in part, "wherein each of the inlet, outlet, and medial portions of the exterior surface is exteriorly threaded" and "wherein each of the inner intermediate portion and outer intermediate portion of the exterior surface is smooth and free of exterior threads". This feature of the invention, clearly shown in all of the drawings of the application, is submitted to provide a more visually appealing appearance to the output conduit, particularly the portion that is exposed to the exterior of the structure. As the output conduit may be needed to extend for a distance outside the wall to deposit the water at a sufficient distance from the wall, the threaded exterior of the output conduit is less visually appealing, and more difficult to paint if that is desired. It is submitted that none of the cited patents, either alone or in combination with each other, would lead one of ordinary skill in the art to this relationship of the invention.

Further, added claim 25 requires "a backing member having an aperture through which the output conduit extends, the output conduit being removably coupled to the medial portion of the exterior surface of the output conduit by interior threads formed on the aperture of the backing member", "wherein the backing member has a substantially planar inward surface extending radially outwardly from the aperture of the backing member toward an outer perimeter of the backing member", and "wherein the inward surface of the backing member is oriented at an oblique angle to a longitudinal axis of the output conduit when the backing member is threaded onto the exterior surface of the output conduit for permitting the backing member to abut against an oblique outer surface of the wall in a substantially uniform manner". These features of the invention, which include the threaded mounting of the backing member to the output conduit and the oblique orientation of the inward surface of the backing plate, all shown in Figures 1 and 2 of the drawings of the application, are submitted to facilitate mounting of the invention on a wall having an inclined outer

Appln. No. 10/671,214

Amendment dated November 17, 2004

Reply to Office Action mailed August 17, 2004

surface such that one portion of the perimeter of the backing member does not applying more pressure to, and dig into, the outer surface, as would happen with a more orthogonal orientation. It is submitted that this relationship is not disclosed by the patents cited in the Office Action. In particular, the Schmidt patent shows a collar washer that is loosely positioned about a pipe, but lacks any positive connection, such as threading between the collar washer and the pipe that would resist rocking of the pipe with respect to the wall. Instead, and contrary to the threaded mounted of the claimed invention, the Schmidt assembly relies upon sufficient pinching force being applied by the nut against the skewed washers to hold the parts in place. The Schmidt assembly requires a significantly greater amount of pressure to be applied to the wall to hold the assembly against rocking than the claimed invention.

It is therefore submitted that the cited patents relied upon in the rejections of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 21 through 28, and therefore these claims are also submitted to be in condition for allowance.

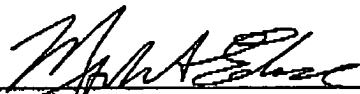
Appln. No. 10/671,214  
Amendment dated November 17, 2004  
Reply to Office Action mailed August 17, 2004

**CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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